

UNITED STATES PATENT AND TRADEMARK OFFICE  
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September 21, 2020

**Opposition No. 91254358 (Parent Case)**  
**Cancellation No. 92073584**

*Mattel, Inc.*

*v.*

*Mattelsa S.A.S*

**J. Krisp, Interlocutory Attorney:**

These proceedings are before the Board for consideration of Opposer/Petitioner Mattel, Inc.'s (Mattel) motions, filed on May 4, 2020 in each proceeding, to strike certain of Applicant/Respondent Mattelsa S.A.S.'s (Mattelsa) affirmative defenses set forth in its answers. The motions to strike are fully briefed.<sup>1</sup>

**CONSOLIDATION**

Mattel's motion includes a motion to consolidate these proceedings. Mattelsa does not oppose the motion.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or

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<sup>1</sup> The Board has reviewed the parties' briefs, but does not repeat or discuss all of the arguments therein, and does not address irrelevant arguments. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993). TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 511 (June 2020).

These proceedings involve the same parties, and involve common questions of law and fact, as well as the same claims and defenses. The proceedings were filed on the same date, and an answer was filed in each proceeding. Consolidation is appropriate. Accordingly, these proceedings are hereby consolidated, and may be presented on the same record and briefs. *Hilson Research Inc. v. Society for Human Resource Mgmt.*, *supra*; and *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in **Opposition No. 91254358 as the “parent case.”** From this point forward the parties shall file a single copy of all motions, briefs and submissions in the parent case only, shall include in the caption all consolidated proceeding numbers, and shall list and identify the “parent case” first, as in the caption above.<sup>2</sup>

Despite being consolidated each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the decision shall be entered into each proceeding file.

## **MOTIONS TO STRIKE AFFIRMATIVE DEFENSES**

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<sup>2</sup> The parties are directed to promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

Trademark Rules 2.106(b)(2) and 2.114(b)(2) provide for the pleading of various affirmative defenses in an answer to a pleading. TBMP § 311.02. The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. Fed. R. Civ. P. 12(f); TBMP § 506; *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Internet Inc. v. Corp. for Nat'l Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996); *Am. Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). The Board also has the authority to strike an impermissible or insufficient claim, or portion of a claim, from a pleading. TBMP § 506.01. A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *Id.*

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d at 1292. The primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Id.* See also, TBMP §§ 309.03 and 506.01. Thus, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *Harsco Corp. v. Elec. Sci. Inc.*, 9 USPQ2d 1570 (TTAB 1988).

Opposition No. 91254358 involves application Serial No. 88577553, filed on August 13, 2019, to register the stylized mark MATTELSA for retail store services

featuring a variety of identified products, in International Class 35, based on Trademark Act Section 44(e).

Cancellation No. 92073584 involves Registration No. 5725469, registered on the Principal Register on April 16, 2019, for the stylized mark MATTELSA for various apparel goods in International Class 25.

In each proceeding, 1) Mattel asserts claims of priority and likelihood of confusion, dilution by blurring and false suggestion of a connection; 2) Mattelsa filed a timely answer which includes various affirmative defenses; and 3) Mattel filed a motion to strike certain affirmative defenses.

In Opposition No. 91254358, Mattelsa challenges the motion to strike as untimely. 7 TTABVUE 3. In its reply brief, Mattel acknowledges the timing of its motion. 8 TTABVUE 2-3.<sup>3</sup> The Board may act on a motion to strike made within 21 days after service upon the moving party of the pleading that is the subject of the motion. Fed. R. Civ. P. 12(f); TBMP § 506; *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *Am. Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). Inasmuch as the Board may entertain an untimely motion to strike matter from a pleading, and to achieve clarification of the pleadings, the Board exercises its discretion to give consideration to the motion to strike filed in the opposition proceeding.

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<sup>3</sup> In this order, the Board's references to the records cite to the proceeding being discussed under the respective heading. The parties should utilize this method of citing to the record, wherever possible. TBMP §§ 106.03 and 801.01; *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

With each of its briefs contesting the motion to strike, Mattelsa submitted, and included a request for leave to file, an amended answer wherein it sets forth amended affirmative defenses. Mattelsa's amended answers are its operative pleadings in the respective proceedings. Fed. R. Civ. P. 15(a)(2); TBMP § 507.02.

In each proceeding, Mattel maintains in its reply brief that the respective amended affirmative defenses do not cure the deficiencies argued in its motion.

**Opposition No. 91254358**

In its answer filed on April 3, 2020, Mattelsa set forth four affirmative defenses.

Mattel moved to strike the first affirmative defense, which read:

The Notice of Opposition fails to state a sufficient basis on which to oppose the registration of Applicant's mark and fails to state a claim upon which relief may be granted.

In its amended answer (7 TTABVue 14), Mattelsa amended the first affirmative defense to:

The Notice of Opposition fails to state a sufficient basis on which to oppose the registration of Applicant's mark and fails to state a claim upon which relief may be granted. Specifically, Opposer fails to sufficiently plea facts necessary to oppose Applicant's registration, including, (1) failure to plea ownership of U.S. Registration No. 2,152,707 in connection with goods in classes 009 and 028; (2) the failure to establish a likelihood of confusion between the pleaded marks and the MATTELSA mark; and, (3) Opposer's lack of standing.

In its reply brief, Mattel maintains that the affirmative defense is insufficiently pleaded. 8 TTABVue 4-5.

As for Mattelsa's assertion that the notice of opposition fails to state a claim upon which relief can be granted, this is not an affirmative defense but rather a challenge to the legal sufficiency of the pleading. Such a challenge should be properly brought

by way of a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6). Nonetheless, the substance of Mattel's pleading is before the Board, and it is reviewed for sufficiency.

To plead entitlement to a statutory cause of action under Section 13 of the Trademark Act, an opposer must allege a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at \*3 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).<sup>4</sup>

In the notice of opposition, Mattel alleges a claim of priority and likelihood of confusion pursuant to Trademark Act Section 2(d) that is not wholly without merit and is based on current ownership of eighteen valid and subsisting pleaded registrations for its MATTEL marks covering a variety of goods and services. It submitted status and title copies of its pleaded registrations from the Office's TESS database. 1 TTABVue 18, 26. Trademark Rule 2.122(d); TBMP § 309.03(b). By doing this, Mattel has alleged matters which, if proven would establish its real interest in the proceeding and reasonable belief of damage. *Cunningham v. Laser Golf Corp.*,

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<sup>4</sup> The Board's previous decisions analyzed the requirements of Sections 13 (and Section 14) under the rubric of "standing." Mindful of the Supreme Court's direction in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), the Board now refers to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, the Board's prior decisions and those of the Federal Circuit interpreting Section 13 (and Section 14) remain equally applicable.

222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

In addition to likelihood of confusion, Mattel also sufficiently alleges the elements of a claim of dilution pursuant to Trademark Act Section 13(a). *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1292 (TTAB 2016); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001); *Polaris Indus. Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000). 1 TTABVUE 18. Lastly, it sufficiently alleges the elements of a claim that Mattelsa's involved mark falsely suggests a connection with Mattel's name or identity pursuant to Trademark Act Section 2(a). *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983); *Nike, Inc. v. Palm Beach Crossfit, Inc.*, 116 USPQ2d 1025, 1031-32 (TTAB 2015). 1 TTABVUE 18-19.

As for the purportedly substantive matters Mattelsa included in the affirmative defense, Mattel's arguments in support of striking these matters are correct. Regarding pleading Registration No. 2152707, the fact that the Office records show that the goods in International Classes 9 and 28 have been amended or deleted does not affect Mattel's opportunity to rely on the registration with respect to the subsisting identification of goods and services. Furthermore, at the pleading stage Mattel need not establish the elements of any of its claims. *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

In view of these findings, Mattel's motion is **granted**. Mattelsa's first affirmative defense is stricken.

**Cancellation No. 92073584**

In its answer filed on April 14, 2020, Mattelsa set forth seven affirmative defenses. Mattel moved to strike the first (fails to state a claim), sixth (doctrine of laches), and seventh (doctrines of waiver, acquiescence, estoppel) affirmative defenses.<sup>5</sup> 6 TTABVUE 3-4.

In its amended answer (8 TTABVUE 16), Mattelsa amended the first affirmative defense to the following, as it did in the opposition:

The Notice of Opposition fails to state a sufficient basis on which to oppose the registration of Applicant's mark and fails to state a claim upon which relief may be granted. Specifically, Opposer fails to sufficiently plea facts necessary to oppose Applicant's registration, including, (1) failure to plea ownership of U.S. Registration No. 2,152,707 in connection with goods in classes 009 and 028; (2) the failure to establish a likelihood of confusion between the pleaded marks and the MATTELSA mark; and, (3) Opposer's lack of standing.

For the same reasons that the Board sets forth above with respect to the opposition proceeding, Mattel's motion is **granted** and the first affirmative defense is stricken.

Mattelsa also amended the sixth and seventh affirmatives defense to:

The claims set forth in the Petition for Cancellation are barred in whole or in part by the doctrine of laches. Specifically, on information and belief, Petitioner has unreasonably delayed in asserting its alleged rights against Registrant causing material prejudice due to that delay. This unreasonable delay and prejudice include the parties' marks

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<sup>5</sup> For clarity, Mattelsa's defenses of laches, waiver, acquiescence and estoppel, as set forth in the original answer, were merely pro forma conclusory statements that the claims "are barred in whole or in part," and set forth no factual allegations that would put Mattel on fair notice of the alleged basis for any of these defenses. 5 TTABVUE 5-6.



coexistence without any confusion or challenge by Petitioner in the United States and abroad, as well as Petitioner's failure to oppose U.S. Registration No. 5,725,469 for the MATTELSA mark.

The claims set forth in the Petition are barred in whole or in part by the doctrines of waiver, acquiescence, and estoppel. Specifically, on information and belief, Petitioner's actions establish its assent to Registrant's registration of U.S. Registration No. 5,725,469 for the MATTELSA mark. Said actions include Petitioner's delay in asserting any claimed rights against Registrant and Petitioner's implied consent to the parties' marks coexistence without any confusion in the United States and abroad.

7 TTABVUE 20.

Mattel maintains that the defenses are insufficiently pleaded, and in particular that they are merely conclusory and set forth no facts to apprise it of the factual bases for the defenses. As for laches, it argues that Mattelsa does not allege supportive facts, including to give notice of the basis for the assertion of "material prejudice." As for waiver, Mattel argues that Mattelsa pleads no facts to give notice of the basis for alleging intentional relinquishment of rights or implied consent. As for acquiescence and estoppel, it argues that Mattelsa does not allege facts to give notice of the basis for alleging misleading conduct.<sup>6</sup> 9 TTABVUE 5-7.

The availability of the laches and acquiescence doctrines is severely limited in cancellation proceedings. *See, e.g., Nat'l. Cable Television Assoc., Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) (laches runs

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<sup>6</sup> The Board notes that Mattelsa did not file a brief in response to Mattel's arguments maintaining its motion to strike as directed to Mattelsa's amended affirmative defenses. Indeed, sur-reply briefs are disallowed. Trademark Rule 2.127(a). In view of the Board's ruling herein granting the motion to strike, and so as to allow Mattelsa the opportunity to address deficiencies in its amended defenses, the Board allows leave to file a second amended answer in Cancellation No. 92073584.

from the time action could be taken against the acquisition of trademark rights which flow from registration of mark); *Ava Ruha Corp. v. Mother's Nutritional Ctr., Inc.*, 113 USPQ2d 1575, 1580 (TTAB 2015) ("[I]n a cancellation proceeding, laches begins to run no earlier than the date the involved mark was published for opposition (if there was actual knowledge), and no later than the issue date of the registration (when Plaintiff is put on constructive notice.")). Mattelsa is bound by such restrictions. Moreover, with respect to each of the four equitable doctrines, Mattelsa alleged, in its amended defenses, little more than conclusory statements that Mattel unreasonably delayed in asserting its rights, that there has been material prejudice due to delay, and that the marks have coexisted without confusion. As for Mattel's alleged actions or conduct, Mattelsa merely alleges little more than that Mattel did not take action until now. It does not set forth when Mattel's relevant alleged conduct took place, a matter relevant to an equitable estoppel defense, or what Mattel knew with respect to Mattelsa's use of its mark. Mattelsa's allegations are conclusory and lack specific factual matters. In sum, the amended defenses do not set forth specific facts which could serve to place Mattel on fair notice of the bases therefor.

In view of these findings, with respect to Mattelsa's amended sixth and seventh affirmatives defenses, Mattel's motion is **granted**, and the defenses are stricken.

The Board allows Mattelsa leave to file an amended answer to the petition to cancel. TBMP § 503.03. Accordingly, Mattelsa is allowed until thirty days from the date of this order to file a second amended answer to the petition to cancel, so as to address the pleading deficiencies in its sixth and seventh affirmatives defenses,

failing which the Board will give said defenses no consideration. Inasmuch as the proceedings are now consolidated, the second amended answer, if filed, is to be filed in the parent case.

## **SCHEDULE**

Proceedings in these consolidated proceedings are **resumed**. The Board presumes that the parties have not held their discovery and settlement conference. Accordingly, time to file a second amended answer is as noted above, and conference, discovery and trial dates are reset as follows:

Deadline for Required Discovery Conference	11/18/2020
Discovery Opens	11/18/2020
Initial Disclosures Due	12/18/2020
Expert Disclosures Due	4/17/2021
Discovery Closes	5/17/2021
Plaintiff's Pretrial Disclosures Due	7/1/2021
Plaintiff's 30-day Trial Period Ends	8/15/2021
Defendant's Pretrial Disclosures Due	8/30/2021
Defendant's 30-day Trial Period Ends	10/14/2021
Plaintiff's Rebuttal Disclosures Due	10/29/2021
Plaintiff's 15-day Rebuttal Period Ends	11/28/2021
Plaintiff's Opening Brief Due	1/27/2022
Defendant's Brief Due	2/26/2022
Plaintiff's Reply Brief Due	3/13/2022
Request for Oral Hearing (optional) Due	3/23/2022

If either of the parties or their attorneys have a change of address or email address, the Board must be so informed. TBMP § 117.07.

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony

periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

### **TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS**

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.<sup>7</sup> The Board will not extend or reset proceeding schedule dates or other deadlines to allow

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<sup>7</sup> To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.

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time to re-file documents. For more tips and helpful filing information, please visit the [ESTTA help](#) webpage.